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EXAMINER

RIVIERE, HEIDI M

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3689

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12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/799,826

Applicant(s)FORGET SHIELD, DANIELLE
RENEE**Examiner**

HEIDI RIVIERE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the rejections of **claims 1-23** under **Kasik (US 6,448,898 B1) and Hassett (US 5,347,274)** have been considered and are not persuasive. Therefore, the rejection has not been withdrawn. Applicant has amended claims 1 and 12 to include the limitation of tracking the waste storage unit at a variety of locations. Examiner has since used the **Hershey et al. ((US 6/108,524)** (hereinafter "**Hershey**") to reject these limitations. Hershey teaches the importance of tracking containers since they are valuable leased equipment. The tracking performed via GPS allows for entry of multiple locations along the delivery route. Furthermore, Kasik also allows the operator to use a touch screen to input data in regards to the audit. (col. 9, lines 30-50) and a laptop can be used as well to input data in situations that necessitate manual entry. (col. 10, lines 1-15)
2. Claims 2 and 16 have been amended and therefore the 112 paragraph 2 rejections are withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. **Claims 1, 3-15, 17-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kasik (US 6,448,898 B1)** in view of **Hershey et al. (US 6/108,524)** (hereinafter "**Hershey**").

5. **With respect to claim 1: (Currently Amended)** Kasik discloses:

a. billing a customer associated with a waste removal, and paying personnel for services associated with the waste removal; (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system) and

b. an electronic portable unit having a memory, processor, an input element, and an output element, the portable unit adapted to allow an operator during the waste removal to use the portable unit and to allow onsite input at a customer facility from preprogrammed queries regarding the waste removal and further being adapted to generate an output of the data to the base system for processing. (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system).

Kasik does not teach, however Hershey teaches:

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c. a waste management electronic base system having a memory, processor, an input element, and an output element, the base system adapted to process waste management data for tracking a waste storage unit at a variety of locations, (Hershey: Figs. 1-2;—col. 1, lines 12-22; col. 3, lines 20-47; col. 4, lines 33-58; col. 5, lines 10-61 - "mobile tracking unit 10 includes a suitable transceiver 52 functionally independent from the navigation set...Transceiver 52 is capable of transmitting the vehicle position data by way of communication link 14 (Fig. 1) to the central station...A low power, short distance radio link is employed between multiple location/tracking units to hold down power consumption and increase reliability and functionality of the tracking system.")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kasik and Hershey. Kasik teaches a system for auditing refuse collection. This system includes structure for billing subscribers. Hershey teaches "while goods are an example of assets that need to be tracked, the containers, container trucks and railcars in which the goods are shipped are themselves assets which need to be tracked, not just because of the goods they carry, but also because they represent capital assets typically of a leasing company not associated with the carrier." (Hershey col. 1, lines 15-22)

6. **With respect to claims 3 and 17:** Kasik teaches the waste comprises industrial waste and the system is adapted to comply with a manifest associated with the industrial waste. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 50-62 - system contains pre-programmed information about the customer and site; this

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information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number)

Furthermore, the data identifying type of waste is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying type of waste adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional

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descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

7. **With respect to claim 4:** Kasik teaches the base system generates a manifest based on information from a generator of waste obtained from the portable unit. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 50-62 - system contains pre-programmed information about the customer and site; this information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number; col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system)

8. **With respect to claims 5 and 20:** Kasik teaches the onsite input allows operator input, automatic input, or a combination thereof. (col. 7, line 35-col. 8, line 47 – process of inputting data from waste container is done automatically).

9. **With respect to claims 6 and 21:** Kasik teaches the onsite input comprises a scanner, keyboard, touch screen, wireless interface, voice recognition interpreter,

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preprogrammed cards, or a combination thereof. (col. 9, line 50-col. 10, line 36 - service vehicle has wireless system).

10. **With respect to claim 7:** Kasik teaches the portable unit output comprises a wireless interface with the base system. (col. 9, line 50-col. 10, line 36 – wireless LAN system).

11. **With respect to claim 8:** Kasik teaches the system further comprises multiple portable units for multiple operators during their respective routes for multiple waste removals. (col. 10, lines 55-60 – system allows more than one data access points).

12. **With respect to claims 9 and 13:** Kasik teaches the base system is adapted to provide download information to the portable unit, the information containing instructions to the operator for a route of the operator. (col. 7, lines 35-67; col. 8, lines 16-65; col. 9, line 30-col. 10, line 36 – service vehicle has wireless system; wireless LAN system; system processes data from the vehicle which is obtained from the container; when the operator is alerted that the system is not able to identify the subscriber, the operator can then follow the steps of taking a renewed reading, perform a manual reading or enter the information manually, for example; a laptop can be used as well to input data in situations that necessitate manual entry).

Furthermore, the data identifying type of information is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim

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limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying type of information adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

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13. **With respect to claims 10, 14 and 23:** Kasik teaches the portable unit is adapted to require predetermined operator input for a first operation to release the operator to perform a next operation. (col. 6, lines 32-43; col. 6, line 44-col. 8, line 65 - after collection flag automatically returns to original position; data regarding collection is inputted into system).

14. **With respect to claims 11 and 19:** Kasik teaches the portable unit is adapted to output an invoice for a customer at the customer site relative to the waste removal. (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system).

15. **With respect to claim 12: (Currently Amended)** Kasik teaches:

- i. billing a customer associated with a waste removal; and
- ii. paying personnel for services associated with the waste removal;

(col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system) and

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b. using an electronic portable unit having a memory, processor, an input element, and an output element, to gather onsite data for the base system, comprising:

- i. allowing an operator to input onsite data at a customer facility into the portable unit from preprogrammed queries regarding the waste removal; and
- ii. generating an output of the data to the base system for processing.

(col. 7, lines 35-67; col. 8, lines 16-65; col. 9, line 50-col. 10, line 36 – service vehicle has wireless system; wireless LAN system; system processes data from the vehicle which is obtained from the container).

Kasik does not teach, however Hershey teaches:

- iii. tracking a waste storage unit at a variety of locations;

(Hershey: Figs. 1-2;—col. 1, lines 12-22; col. 3, lines 20-47; col. 4, lines 33-58; col. 5, lines 10-61 - "mobile tracking unit 10 includes a suitable transceiver 52 functionally independent from the navigation set...Transceiver 52 is capable of transmitting the vehicle position data by way of communication link 14 (Fig. 1) to the central station...A low power, short distance radio link is employed between multiple location/tracking units to hold down power consumption and increase reliability and functionality of the tracking system.")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kasik and Hershey. Kasik teaches a system for

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auditing refuse collection. This system includes structure for billing subscribers. Hershey teaches “while goods are an example of assets that need to be tracked, the containers, container trucks and railcars in which the goods are shipped are themselves assets which need to be tracked, not just because of the goods they carry, but also because they represent capital assets typically of a leasing company not associated with the carrier.” (Hershey col. 1, lines 15-22)

16. **With respect to claim 15:** Kasik teaches scanning input information into the portable unit regarding a waste storage unit. (col. 7, lines 5-23 – containers can have barcode markings/labels that can be accessed and read).

17. **With respect to claim 18:** Kasik teaches accepting an electronic manifest into the portable unit. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 50-62 - system contains pre-programmed information about the customer and site; this information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number).

18. **With respect to claim 22:** Kasik teaches sharing information between the portable unit and the base system through a wireless interface. (col. 7, lines 35-67; col. 8, lines 16-65; col. 9, line 50-col. 10, line 36 – service vehicle has wireless system; wireless LAN system; system processes data from the vehicle which is obtained from the container).

19. **Claims 2 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kasik** in view of **Hershey** and further in view of **Hassett (US 5,347,274)**.

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20. **With respect to claims 2 and 16: (Currently Amended)** Kasik/Hershey teaches the limitations in the rejections above. However, Kasik/Hershey does not teach a waste removal vehicle, wherein the waste storage unit is selectively coupled with the waste removal vehicle. Hassett teaches a waste removal vehicle, wherein the waste storage unit is selectively coupled with the waste removal vehicle. (col. 3, lines 52-62 – “the invention contemplates embodiments adapted to all modes of transport...the term “vehicle” as used in the disclosure and the patent claims herein is to include boat, airplane, truck, rail car or engine, and all other forms of transport vehicle, as well as such tanks, containers or vessels as may demountably attach to or be carried by a transport vehicle”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine to portable wireless waste removal system of Kasik with the waste removal and storage unit in Hassett because of the need to not only have a system where waste can be kept if disposal is not readily available. It is also necessary to have a system that tracks information related to the waste such as location. Kasik teaches a system for auditing refuse collection. This system includes structure for billing subscribers. Hershey teaches “while goods are an example of assets that need to be tracked, the containers, container trucks and railcars in which the goods are shipped are themselves assets which need to be tracked, not just because of the goods they carry, but also because they represent capital assets typically of a leasing company not associated with the carrier.” (Hershey col. 1, lines 15-22)

CONCLUSION

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689